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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,640	07/28/2003	John P. Stautner	200303370-3	4896

7590 02/23/2007

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EXAMINER	
BAUTISTA, XIOMARA L	
ART UNIT	**PAPER NUMBER**
2179	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/628,640	STAUTNER ET AL.	
	Examiner	Art Unit	
	X. L. Bautista	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/28/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 14-46 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of prior U.S. Patent No. 6,600,503 B2. This is a double patenting rejection.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both, the prior patent and the pending application claim a method and system for delivering and displaying content selection information as an electronic program guide (EPG) for providing content selection information from a plurality of content sources to a user; the content selection information having descriptive information associated with the content, integrating and adapting the content selection information for display in the (EPG), defining an action associated with the content selection information, and defining an indicator

or selectable portion that corresponds to the action and enabling a user to perform the associated action by selecting the indicator.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. **Claims 14-46 are rejected under 35 U.S.C. 102(e) as being anticipated by *Matthews, III et al* (US 6,025,837).**

Claims 14 and 25:

Matthews discloses a system and method for delivering content selection information to be displayed as a content selection guide (abstract; figs. 5 and 7; col. 4, lines 28-30, 48-65; col. 5, lines 66-67; col. 6, lines 1-3). Matthews teaches providing content selection information having descriptive information. The content selection information is adapted to be displayed within a plurality of selectable guide cells (figs. 2, 5 and 7). Matthews teaches providing content selection information from a plurality of (TV, Internet) content sources to a user (col. 1, lines 55-57; col. 2, lines 26-31). Matthews teaches hyperlinks that reference target resources containing interactive supplemental content related to the programs (figs. 2, 3 and 5). Matthews explains that the hyperlinks can be placed within the program tiles, channel tiles, or description area, and can be situated alone or embedded within other text. When a user activates a hyperlink, a target resource specified by the hyperlink is activated (defining an action to be associated with content selection information that is to be displayed in the selectable guide cells). The hyperlinks are indicators that correspond to the action, and these indicators enable the user to initiate the action when being selected by the user (col. 3, lines 55-63; col. 4, lines 28-32, 48-58; col. 9, lines 56-60).

Claims 15, 26 and 37:

Matthews teaches that the hyperlinks are rendered as a graphical icon (col. 2,

lines 43-56).

Claims 16, 17, 27, 28, 38 and 39:

Matthews teaches defining a format for the plurality of selectable guide cells based on user preferences or according to predetermined formats (col. 10, lines 36-49).

Claims 18, 29 and 40:

Matthews teaches that a hyperlink can be an executable program (col. 3, lines 55-63; col. 11, lines 52-67; col. 12, lines 1-7).

Claims 19, 30 and 41:

Matthews teaches updated content selection information (abstract; col. 1, lines 21-33; col. 4, lines 27-36, 48-65).

Claims 20, 31 and 42:

Matthews teaches defining the action to comprise displaying an advertisement. Matthew explains that examples of possible supplemental content include interactive questions or games related to the program, additional trivia on the movies or TV shows, advertisements, available merchandise or other memorabilia, Web pages to programs of similar type or starring the same actors/actresses, and so on (col. 7, lines 16-21). Matthews teaches that the system might pre-cache supplemental information about certain shows before they air based on predictive viewing tendencies, or as part of a promotional data broadcast

advertising the show (col. 10, lines 6-10).

Claims 21, 32 and 43:

See claim 20. Matthews teaches defining the action to comprise making a purchase. Matthews teaches that movies-on-demand enable viewers to shop, purchase, and watch a movie at their convenience. Many industry and commercial experts expect interactive TV systems to evolve to the point of offering many other interactive services to the consumers. For instance, consumers will be able to use their TV to shop for groceries or other goods, conduct banking and other financial transactions, play games, or attend educational courses and take exams (col. 2, lines 1-11).

Claims 22, 33 and 44:

Matthews teaches adapting the content selection information to be displayed on a computer system (abstract, lines 1-6; col. 4, lines 27-36; col. 5, lines 24-27, 51-65).

Claims 23, 34 and 45:

Matthews teaches storing the content selection information in a database on a computer system (col. 6, lines 34-45, 59-67; col. 7, lines 1-22).

Claims 24, 35 and 46:

Matthews teaches delivering the content selection information to a user via a wireless communication channel (col. 6, lines 7-21).

Claim 36:

See claim 14. Matthews teaches a machine-readable medium directing a computer device to perform the invention as claimed in claims 14-46 (see claim 10 in col. 14).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X. L. Bautista whose telephone number is (571) 272-4132. The examiner can normally be reached on Tuesday-Friday 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

X. L. Bautista
Primary Examiner
Art Unit 2179

xlb
February 16, 2007